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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,763	06/26/2000	Tsuyoshi Katayama	2185-0452P-SP	3604

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/18/2002 13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/604,763

Applicant(s)

KATAYAMA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) 31 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claims 17-32 are pending. Claims 31-32 are withdrawn from consideration, as they are directed toward non-elected subject matter. The Amendment filed May 10, 2002, cancelled claim 16, amended claims 17, 18, 22, and 27, and added claims 29-32.

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed May 12, 2002 (Paper No. 12) to the rejection of claims 16-28 made by the Examiner under 35 USC 102 and 103 have been fully considered and deemed not persuasive.

Election/Restrictions

Newly submitted claims 31-32 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: A method of making a composition is patentably distinct from a composition.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 31-32 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

102 Rejection Maintained

The rejection of claim 18 and newly added claim 29 under 35 U.S.C. 102(b) as being unpatentable over Kigawa et al. (5,798,434) is MAINTAINED for the reasons set forth in the Office Action mailed February 12, 2002, Paper No. 11, and those found below.

Applicant argues, "Kigawa '434 does not contain the properties required for a skin cosmetic or external skin agent. For example, sensorial properties are not present in the polymer

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of Kigawa '434 and this property is needed in cosmetics for application to the skin". This argument is not persuasive. The polymers disclosed by Kigawa '434 and those of the instant invention are the same. Thus, they must have the same properties. The Examiner respectfully points out that a compound and its properties are inseparable. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Regarding claim 29, the Examiner also respectfully points out that a recitation of the intended utility in the preamble does not impart patentability to a known composition. In re Spada, 911 F.2d 705, 15 USPQ 2d 1655 (Fed. Cir. 1990).

103 Rejection Maintained

The rejection of claims 17-28 and newly added claims 29-30 under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (5,795,978) in view of Hartmann et al. (5,739,190) or in view of Akrongold et al. (3,846,550) in further view of Bernhardt et al. (4,788,054) or in further view of Clum et al. (5,652,263) is MAINTAINED for the reasons set forth in the Office Action mailed February 12, 2002, Paper No. 11, and those found below.

Applicant argues, "the present invention exhibits superior properties over cosmetics or external skin agents not containing the specific dimerdiol ester of the present invention. For example, the present invention has superior alkali hydrolysis resistance, stability, safety and superior feelings of use". This argument is not persuasive, as showings of fact are much preferred to statements of opinion. In re Oelrich, 198 UWPQ 210, 215 (CCPA 1978).

Applicant argues, "However, Ansmann does not disclose or suggest using the dimerdiol in a cosmetic as opposed to the other fatty acids disclosed. . .A complete reading of Ansmann does not motivate one to use a dimer diol in a cosmetic. In fact, in the examples of Ansmann triglycerides based on C6-C10 fatty acids are used. . .Hartmann discloses also a laundry list of

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alcohols, including the dimerdiol of the present invention. However, there is no teaching to use the specific dimerdiol in a cosmetic as with the present invention". This argument is not persuasive. First, the Examiner again respectfully points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Second, the Examiner respectfully points out that the Ansmann patent is directed to new emulsifiers for the production of cosmetic formulations. Furthermore, it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kalso*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983).

Applicant argues, regarding Hartmann, "a claim is not per se obvious when a component of the present invention is disclosed in a genus and there is not motivation to pick out the specific species from amongst the many members of the genus". This argument is not persuasive. First, the Examiner respectfully points out that the instant invention is not directed to species, but is directed to a genus. Second, the Examiner respectfully points out that Hartmann was relied upon for its teachings of fatty acid chain lengths for fatty acids which can be combined with polyhydric alcohols.

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Applicant argues, "Clearly, the teachings of Hartmann are in conflict with the teachings of Ansmann. As such, one of ordinary skill in the art would not be motivated to combine teachings to arrive at the present invention". This argument is not persuasive. Ansmann et al. and Hartmann et al. both teach polyhydric alcohols with long-chain fatty acids as emulsifiers in organic emulsions. Thus, one of ordinary skill would be motivated to combine their teachings.

Applicant argues "the esters of Akrongold are used as oils and not as emulsions in combination with urea to produce a powder product. In contrast, the esters in Ansmann are used as oils for emulsion with water to product o/w emulsion. This contrast is a prime example of why these references may not be combined". This argument is not persuasive. Akrongold and Ansmann are both directed to cosmetic compositions comprising dimer acids. Akrongold is relied upon for teachings on the number of carbon atoms a dimer acid in a cosmetic composition. Hence, there is motivation to combine the two references.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The phrase "wherein said cosmetic or external agents is a skin cosmetic or external skin agent" in claim 29 is vague and indefinite, as it is confusing. Does the composition comprising a dimerdiol/dimerdiester and another ingredient?

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(ii) Claim 30 is vague and indefinite. See line 4, how are fats and oils different? See lines 7-8, what is keratin ablation agent? What is resolution agent? See line 9, what is a refrigerant and how would it be applied to a cosmetic composition? See line 9, what compounds are encompassed by the term "reductant"? See line 10, what compounds are encompassed by the terms, "stimulant, hair growth agent, polymer powder". See lines 11-12, what compounds are encompassed by the term "derivatives thereof"? See line 13, what compounds are encompassed by the phrase "aromatic agents"?

Unexpected Results

It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case there are no unexpected results.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
June 6, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
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